In the Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-301

GERALD B. BAUMAN, PETITIONER

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

Petitioner filed with the Commissioner of Patents an application for a patent on a "Geographical Locater System", through which any location in a given geographic area may be identified by reference to its position within a systematic grid (Pet. 3). The grid divides the area into equal rectangles, numbered *seriatim*; each rectangle, in turn, is subdivided into equal rectangles with corresponding numbers, and these smaller rectangles are again subdivided. Accordingly, any location may be identified as a series of

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numbers, signifying its position within progressively smaller rectangular units (Tr. 12–22).[1]

A primary examiner in the Patent Office concluded, *inter alia,* that petitioner's claimed invention[2] was "obvious" in light of the prior art (35 U.S.C. 103), including a patent issued to Baugh in 1887 (Tr. 52). Accordingly, the application was rejected. The Patent Office Board of Appeals affirmed the examiner's decision on this ground (Tr. 54); the Court of Customs and Patent Appeals affirmed, holding that "the evidence of record indicates that the claimed subject matter would have been obvious to one of ordinary skill in the art" (Pet. App. 2a).

Contrary to petitioner's contention (Pet. 7), the Board of Appeals carefully compared the distinctive features of petitioner's claimed invention with the prior art, as required by 35 U.S.C. 103.[3] In rejecting the claimed invention on the basis of obviousness in light of the prior art, the Board of Appeals stated (Pet. App. 8a–10a):

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[1] "Tr." designates the Transcript of Record in the United States Court of Customs and Patent Appeals.

[2] Petitioner's application contained three independent claims and nine dependent claims. Claim 17, the only independent "method" claim, described the substance of petitioner's claimed invention; the dependent claims entailed particular applications of it. See 37 C.F.R. 1.75(e).

[3] 35 U.S.C. 103 provides in pertinent part that: "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

> [Petitioner] emphasizes that the meaning of a digit remains the same as he uses it regardless of the level for which it is used. This is the concept that [petitioner] finds lacking in the prior art. * * *
>
> In our opinion Baugh is the strongest piece of evidence presented by the examiner. Baugh describes a method of dividing a plot of land into an area made up of four squares and then subdividing each of these smaller areas into four smaller squares and then dividing each of these smaller squares into four more squares and then designating each of the small subdivided areas by numbers or letters. This is the essence of [petitioner's] method. * * * We also find it obvious to have a number retain a single meaning whenever used.

As this Court noted in *Graham* v. *John Deere* Co., 383 U.S. 1, 18, "[w]hat is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context." A finding of obviousness will be deemed correct so long as it is based, as here, upon a careful comparison between the scope and content of prior art and the claimed invention, in light of the level of ordinary skill in the pertinent art (*id.* at 17). Accordingly, the Court of Customs and Patent Appeals correctly affirmed the Board of Appeals' decision sustaining the finding of nonpatentability.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

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